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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,273	02/01/2001	Frank M. Sexton	103	7225

7590

01/17/2006

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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/775,273

Applicant(s)

SEXTON ET AL.

Examiner

Vivek D. Koppikar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Application***

1. Claims 1-11 have been examined in this application. This Office Action is in response to the remarks and amendment filed on March 11, 2005.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,752,236 to Sexton in view of "Auto-Homeowners packages look like a winner" by McCoy.

For the details of these rejections refer to the Office Action dated December 11, 2004. The rejections of the above mentioned claims from the Office Action dated December 11, 2004 have been incorporated in this Office Action.

4. Claims 2, 4, and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sexton and McCoy as applied to Claims 1 and 5, above, and in further view of "Protect yourself" by Smith.

For the details of these rejections refer to the Office Action dated December 11, 2004. The rejections of the above mentioned claims from the Office Action dated December 11, 2004 have been incorporated in this Office Action.

***Response to Arguments***

5. Applicant's arguments filed March 11, 2005 have been fully considered but they are not persuasive. The applicant's arguments will be addressed in sequential order as they are set forth in the Remarks section dated March 11, 2005.

(A) The applicants argue that there is no teaching or suggestion of forming a prototype policy of three or more insurance coverages. However, the examiner would like to point out that McCoy suggests combining "homeowners and auto coverages". Since McCoy uses the plural forms of these words, the examiner takes the position that an insurance client could combine more than one of each of these types of insurance to form a packaged policy. Therefore, the examiner takes the position that McCoy does in fact teach forming a prototype or package policy of three or more insurance coverages.

(B) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, the examiner takes the position that there is sufficient motivation in McCoy to combine the teachings of McCoy with Sexton because McCoy explicitly states in the article that a packaged combination (prototype policy) provides a forced means of account selling and increased retention (McCoy, Abstract).

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(C) Applicants argue against the non-obviousness rejection based on objective evidence claiming that the two inventors in the Sexton reference are the same two applicants of the current application. However, these arguments do not overcome the non-obviousness rejection because the combined teachings of the prior art clearly disclose the claimed invention. Furthermore, as noted above, there is sufficient motivation to combine the references of Sexton and McCoy.

(D) The applicants argue that Smith reference which has been used to reject claims 2, 4 and 8-11 does not teach the concept of one policy with multiple coverages. However, the examiner points out that the McCoy reference has been used to teach this concept while the Smith reference has been used to show that additional insurance coverages can be purchased to supplement a basic insurance policy and these additional coverages can be selected from the group consisting of life, health, disability, major medical, critical coverages, long-term care, and property and casualty coverages.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following definition has been taken from Barron's "Dictionary of Insurance Terms" (4<sup>th</sup> Edition):

1) package policy—several basic property and/or liability policies combined to form a single policy. For example, the homeowners Insurance Policy is composed of such basic coverages as BROAD FORM PERSONAL THEFT INSURANCE, COMPREHENSIVE PERSONAL LIABILITY, and FIRE INSURANCE-STANDARD FIRE POLICY.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Another resource that is available is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you


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have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

  
Vivek Koppikar

8/18/2005

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER